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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,396	01/16/2002	Denis Labrecque	108184-00017	3427

4372 7590 07/01/2002

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EXAMINER

SMALL, ANDREA D SOUZA

ART UNIT PAPER NUMBER

1626

DATE MAILED: 07/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/046,396

Applicant(s)

LABRECQUE ET AL.

Examiner

Andrea D Small

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19,22-37 and 40-75 is/are rejected.
- 7) ☒ Claim(s) 1-19,22-37 and 40-75 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 09/736027.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

Continuation of Disposition of Claims: Claims withdrawn from consideration are remaining subject matter in claim(s) 1-15, 17, 22-33, 35 and 40-75 in part and claims 20-21 and 38-39.

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-15 in part, 17 in part, 20-21, 22-33 in part, 35 in part, 38, 39 and 40-75 in part drawn to compounds of claim 1 where G2 is a 4 or 5 membered nitrogen containing heterocycle and x is oxygen or sulfur.

Group II, claim(s) 1-15 in part, 17 in part, 20-21, 22-33 in part, 35 in part, 38, 39 and 40-75 in part drawn to compounds of claim 1 where G2 is a 6 or 7 membered nitrogen containing heterocycle and x is oxygen or sulfur.

Group III, claim(s) 1-15 in part, 17 in part, 20-21, 22-33 in part, 35 in part, 38, 39 and 40-75 in part, drawn to compounds of claim 1 where G2 is a 4 or 5 membered oxygen containing heterocycle and x is oxygen or sulfur.

Group IV, claim(s) 1-15 in part, 17 in part, 20-21, 22-33 in part, 35 in part, 38, 39 and 40-75 in part drawn to compounds of claim 1 where G2 is a 6 or 7 membered oxygen containing heterocycle and x is oxygen or sulfur.

Group V, claim(s) 1-15 in part, 17 in part, 20-21, 22-33 in part, 35 in part, 38, 39 and 40-75 in part, drawn to compounds of claim 1 where G2 is a 4 or 5 membered sulfur containing heterocycle and x is oxygen or sulfur.

Group VI, claim(s) 1-15 in part, 17 in part, 20-21, 22-33 in part, 35 in part, 38, 39 and 40-75 in part, drawn to compounds of claim 1 where G2 is a 6 or 7 membered sulfur containing heterocycle and x is oxygen or sulfur.

Group VII, claim(s) 1-19 in part, 22-37 in part and 40-75 in part, drawn to compounds of claim 1 where G2 is a non-heterocycle and X is oxygen or sulfur.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The same special technical feature common to all of the groups is the dicarboxy-substituted heterocycle. This special technical feature was known in the prior art prior to the filing of the instant application (see attached Hartman, et al (WO 94/08577). Therefore, the

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feature does not provide a contribution over the prior art and unity of invention in the instant claims is lacking.

Applicant's election with traverse of Group VII, when G2 is a non-heterocycle and X is oxygen or sulfur in a telephone conversation with Daniel Dzara on June 20, 2002, is acknowledged. Claims 1-19 in part, 22-37 in part and 40-75 in part, drawn to compounds of claim 1 where G2 is a non-heterocycle and X is oxygen or sulfur are examined herein. The remaining subject matter in claim(s) 1-15, 17, 22-33, 35 and 40-75 in part and claims 20-21 and 38-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected group.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- (a) Claims 1-19, 22-37 and 40-75 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1 and 27 have incomplete molecules due to the dangling valences found on the molecules, the divalent nitrogen, the monovalent oxygen, and when G2 is a non-heterocycle, the divalent nitrogen or the monovalent oxygen or sulfur on the molecule. The "how to make" requirement of 35 USC §112, first paragraph has not been met as the application offers no method for preparing an incomplete molecule.

Support is seen only for the specific compounds of the elected area in the examples which are, examples VII, VIII, IX, X, XI, XVIII, XIX, XXI, and XXX.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(a) Claims 1-19, 22-37 and 40-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "comprising" found in the above claims is open-ended and one of enlargement and not restriction. The term "comprising" does not exclude other possibilities of substituents on the molecule than those specifically claimed by the Applicants. The instant application does not provide guidance for ascertaining the possible substituents contemplated and one of ordinary skill in the art would not be appraised as to the metes and bounds of the instant claims. Therefore, the term "comprising", is an improper use of Markush groupings. Ex parte Dotter, 12 USPQ 382 (Bd. App. 1931) (see MPEP 2173.05(h)). Amending the claims to insert the phrase "selected from a group consisting of" instead of comprising would obviate the above rejection.

(b) Claims 1-19, 22-37 and 40-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 27 have incomplete molecules due to the dangling valences found on the molecules, the divalent nitrogen, the monovalent oxygen, and when G2 is a non-heterocycle, the divalent nitrogen or the monovalent oxygen or sulfur on the molecule. The above molecule is incomplete and thereby allows for varying possibilities of substituents to be attached on the molecule. The instant application does not provide guidance for ascertaining the possible substituents contemplated and one of ordinary skill in the art would not be appraised as to the metes and bounds of the instant claims.

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(c) Claims 74 and 75 are indefinite as it is unclear whether Applicants are claiming a product or a method of use. Amending the claims to clarify the type of claim recited is suggested to obviate the above rejection.

### OBJECTIONS

Claims 1-19, 22-37 and 40-75 are objected to as containing non-elected subject matter. These claims limited solely to the elected group as identified supra and overcoming any rejections identified supra would appear allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea M. D'souza, whose telephone number is (703) 305-0811. The examiner can normally be reached on Monday-Thursday from 8:30 AM - 7:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Joseph.McKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1234

Andrea D. Small  
June 21, 2002

  
T. A. Solola, Ph. D.  
Primary Patent Examiner